

REMARKS

Applicant has carefully considered the Examiner's remarks and the prior art cited by the Examiner in conjunction with the current Office Action. Claims 3-4 and 6-8 are pending in the application after this amendment. Claims 1-2 and 5 have been cancelled. Claims 3-4 and 6 have been amended. Claims 7 and 8 have been added. Applicant submits that no new matter has been added by either the amendment of claims 3-4 and 6 or the addition of new claims 7 and 8.

The rejections set forth by the Examiner in the March 13, 2003 Office Action are addressed. These rejections are respectfully traversed, and detailed arguments are set forth below. Reconsideration of claims 3-4 and 6-8 is requested in view of the following remarks.

DOUBLE PATENTING

The Examiner provisionally rejected claims 1 and 2, under 35 U.S.C. § 101, as claiming the same invention as that of claims 1 and 2 of copending Application Serial No. 09/578,058.

The Applicant has cancelled claims 1 and 2 from this application. On this basis, the Applicant respectfully requests that the provisional double patenting rejection be withdrawn.

35 U.S.C. § 102

The Examiner rejected claims 2-6, citing 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 5,430,538 to Kobayashi (the "Kobayashi reference"). Specifically, in the Office Action, the Examiner stated:

"The [Kobayashi reference] describes an apparatus for evaluation of gems, comprising: a surface 16 that is positioned on the object side of the lens of video camera 13 facing away from the lens, and the doughnut-shape surface 16 having an aperture for allowing the gemstones to be viewed on the object side of the lens facing away from the lens; and a plurality of colored sections of a different color."

The Applicant has cancelled claims 2 and 5 of this application. On this basis, the

Applicant respectfully submits that the Examiner's rejection of claims 2 and 5 is moot.

Turning to the Examiner's rejection of claims 3-4 and 6, in order for the Kobayashi reference to anticipate amended claims 3-4 and 6 of applicant's invention, the reference must teach every element of each claim. *See* MPEP 2131. Amended claims 3-4 and 6 of Applicant's invention have been amended as follows:

"3. An invention used in conjunction with a lens for judging a gemstone's brightness and symmetry, comprising:

a cylindrical surface directly attached to the object side of a lens forming an opening through which a gemstone is viewable on the object side of said lens, and wherein said surface is comprised of a plurality of bands, at least one of said bands having a different color from another."

"4. An invention used in conjunction with a lens for judging a gemstone's brightness and symmetry, comprising:

a cylindrical surface directly attached to the object side of a lens forming an opening through which a gemstone is viewable on the object side of said lens, and wherein said surface is comprised of a plurality of colored areas, at least one of said areas having a different color from another."

"6. An invention used in conjunction with a lens for judging a gemstone's brightness and symmetry, comprising:

a surface directly attached to the object side of the lens forming an opening through which a gemstone is viewable on the object side of said lens, and wherein said surface is comprised of a plurality of areas, at least one of said areas having a different color from another."

Applicant respectfully submits that the Kobayashi reference does not disclose every element of amended claims 3-4 and 6 of applicant's invention. Specifically, amended claims 3-4 and 6 of applicant's invention disclose "a surface that is attached directly to the object side of the lens....(emphasis added)." The Kobayashi reference does not disclose a surface 16 that is attached directly to the object side of the lens of a video camera 13. In fact, neither the drawings nor the specification of the Kobayashi reference disclose a light source 14 which is *directly attached to* the lens of a video camera 13 (emphasis added). Rather, the Kobayashi reference discloses a surface 16 "provided on the light beam radiating side of cover 15...." *See*

FIG. 1 and col. 3, lns. 7-9. "Cover 15" is defined as the cover of the light source 14. *See* FIG. 1 and col. 3, lns. 4-7. Applicant submits that the specification and the drawings of the Kobayashi reference clearly set forth a surface 16 which is provided on the cover 15 of the light source. Applicant respectfully submits that the Kobayashi reference does not disclose a surface 16 directly attached to a lens as set forth in amended claims 3-4 and 6 of applicant's invention.

Because the Kobayashi reference does not disclose a surface directly attached to the object side of a lens, it does not disclose every element of amended claims 3-4 and 6 of applicant's invention. On this basis, applicant respectfully submits that the Kobayashi reference cannot anticipate amended claims 3-4 and 6 of applicant's invention.

35 U.S.C. § 103

The Examiner rejected claim 1, citing 35 U.S.C. § 103(a), as being unpatentable over the Kobayashi reference. Applicant has cancelled claim 1 from this application. On this basis, the applicant submits that the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) is moot.

DEPENDENT CLAIMS

New dependent claims 7 and 8 contain subject matter from cancelled claim 5. New claim 7 depends from amended claim 3, while new claim 8 depends from amended claim 4.

Applicant submits that dependent claims 7 and 8 are patentable for the same reasons as were discussed for amended claims 3 and 4, and further in light of the further limitations contained within the dependent claims.

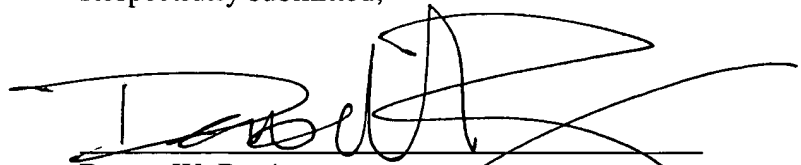
CONCLUSION

In light of the above amendments, applicant respectfully submits that the pending claims in the application are in condition for allowance, and early notice of allowance of the

application is accordingly solicited.

Please charge Deposit Account No. 13-3571 for any additional fees which may be required. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read 'Devon W. Ryning', is written over a horizontal line.

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